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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER BELOUSOV, ANDREY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,251	Applicant(s) WOLFF ET AL.	
	Examiner ANDREY BELOUSOV	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/02/2009, 3/18/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment of 3/10/2010. Claims 1-52 are pending and have been considered below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-10, 12-15, 19, 24-25, 27-30, 31, 33-34, 37-38, 41, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang (5,490,217.)

Claim 1, 19, 31, 38: Wang discloses a method comprising:

- a. representing a first collection (5:36-55, patient's medical record) of media objects (5:36-55, information about the form type, patient's historical information (name, address, social security number, billing rate, insurance information and the like)) on a first sheet (Fig. 7: 22) having a first graphical content representing media objects (5:5-11, pictorial and textural features), wherein the first sheet is a cover sheet (5:36-55) that provides access to the first collection of the media objects (5:36-55, initial patient medical progress chart containing initial information),
- b. wherein the cover sheet is a non-electronic medium (Fig. 7: paper medium; 3:7);

Art Unit: 2174

- c. scanning a first identifier (Fig. 7, barcode) on the first sheet to identify the first collection of media objects using a scanner configured to scan images (3:8-12; Fig. 3, 7; 5:36-55); and
- d. adding one or more other media objects to the first collection of media objects that has been identified by the scanning the first sheet to create a second collection of media objects (5:36-55, recording new information, whether typed or even handwritten); and
- e. re-marking the first sheet that includes printing (5:36-55, Fig. 7: additional recorded, typed information) a second graphical content (Fig. 7: e.g. 12/31 annotation) representing the second collection of media objects (Fig. 7: 16) onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form (Fig. 7: paper form; 3:7),
- f. wherein the re-marked first sheet including the second graphical content in the non-electronic form (Fig. 7: 16) provides access to the second collection of the media objects (5:36-55, updated patient's file.)

Claim 9, 24, 33: Wang discloses the method defined in claim 1 further comprising accessing the first collection using a first identifier, wherein the first identifier comprises a machine-readable identifier (2d bar code; Fig. 7: 16; Fig. 4-6.)

Claim 10, 25, 34, 41: Wang discloses the method defined in claim 9 wherein the machine-readable identifier comprises a barcode (2d bar code; Fig. 7: 16; Fig. 4-6.)

Claim 12, 27: Wang discloses the method defined in claim 1 wherein

- a. re-marking the first sheet only occurs in a first mode of operation (5:37-56, printing / handwriting annotations), and further comprising
- b. marking a second sheet with the second graphical content in a second mode of operation (Fig. 7: updating the barcode),
- c. where the second mode is different than the first mode of operation (first mode is for marking an annotation, whereas the second mode is for the barcode, Fig. 7.)

Claim 13, 28: Wang discloses the method defined in claim 12 wherein marking the second sheet with the second graphical content occurs while erasing the first sheet (Fig. 5.)

Claim 14: Wang discloses the method defined in claim 1 wherein the first sheet comprises a medical information of a patient (5:36-55; whether the information is medical information of a patient or other type of information is of descriptive non-functional nature.)

Claim 15, 29, 30, 37, 44: Wang discloses the method defined in claim 14 wherein the first collection of media objects comprises patient objects regarding a patient, and further wherein the second collection of media objects represents an updated version of the patient objects for the patient (5:36-55.)

Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Sellen et al. (2002/0052888.)

Claim 46: Sellen discloses a method comprising:

- a. determining whether a document is erasable that includes
- b. scanning, using a scanner configured to scan images (par. 5, 25), a portion of the document (Fig. 5: 86, par. 36, paper version of the revised document with changes / annotations) to obtain first scanned data (Fig. 5: 90);
- c. wherein the portion of the document includes a content in a non-electronic form (Fig. 5: 86, par. 36, revised document content on paper)
- d. wherein the document is a non-electronic medium (Fig. 5: 86, document as represented on paper form);
- e. storing the first scanned data in a memory (Fig. 5: 92, it is inherent that in order to OCR content image, it would have to be stored in memory first);
- f. performing, using a peripheral device, an erasing operation (par. 36, revising / updating the paper document portion) on the scanned portion of the document (par. 36, Fig. 5: paper version of the document) that includes the content in the non-electronic form at the location of the portion (0036 – revising the document);
- g. scanning, using the scanner configured to scan the images (par. 5, 25), the portion of the document that has been subjected to the erasing operation to

Art Unit: 2174

obtain second scanned data (scanned data for comparing: Fig. 5: 68, 72-82; 0035, updated content); and

- h. determining whether the document is erasable based on the first scanned data and the second scanned data (Fig. 5: 82; par. 11; it is an inherent determination, given that the document can be altered, including to a blank page; Fig. 5:52-62.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48 and 50-52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Torii et al. (6,432,518.)

Claim 2, 20, 32, 39, 48: Wang discloses the method defined in claim 1. Wang further discloses.

- a. marking the first sheet with a second identifier to identify the second collection and the second graphical content (5:37-56.)

However, Wang does not explicitly disclose further comprising:

- b. erasing the first sheet;

Art Unit: 2174

Torii discloses an erasable recording material (Abstract) for a barcode (22:16) which may be erased and re-marked as needed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wang with Torii. One would have been motivated to utilize the erasable recording material of Torii with the disclosure of Wang so as to enable modification of the barcode in the same position (as illustrated in Fig. 7 of Wang) without taking up any more space on the sheet.

Claim 3: Wang and Torii disclose the method defined in claim 2. Wang further discloses wherein the media objects are scanned pages (Fig. 7, 5:37-56.)

Claim 4: Wang and Torii disclose the method defined in claim 2. Wang further discloses wherein the media objects are electronic documents or images from a digital memory card (retrieved patient's file, 5:55.)

Claim 6, 22, 40, 43, 45: Wang and Torii disclose the method defined in claim 2. Wang further discloses further comprising: accessing the first collection of media objects using the first identifier (5:37-5:56); and scanning the one or more pages of the one or more other media objects (re-scanning the page including the added information, 5:37-5:56.)

Art Unit: 2174

Claim 7, 21, 36: Wang and Torii disclose the method defined in claim 2. Wang further discloses wherein the first identifier and the second identifier are identical (same barcode, Fig. 7: 16.)

Claim 50: Wang discloses a method comprising:

- a. scanning, using a scanner configured to scan images (3:8-12; 5:5-11, pictorial and textural features), a portion of a sheet (Fig. 7) having a non-electronic representation (Fig. 7: 16) of a first collection (5:37-56, patient's record) of media objects (5:37-56, patient historical information, etc. comprising of pages) to identify the first collection of media objects (patient's medical record);
- b. adding one or more other media objects to the first collection of media objects that has been identified by the scanning the sheet, to create a second collection of media objects (5:37-56, rescanned updates);
- c. wherein the representation includes a first graphical content to represent the first collection of the media objects in a non-electronic form (Fig. 7: barcode),
- d. wherein the sheet is a cover sheet including the first graphical content in the non-electronic form that provides access to the first collection of the media objects (5:37-56), wherein the sheet is a non-electronic medium (Fig. 7, paper form); and
- e. marking the portion of the sheet with updated information that includes printing, using a printer, a second graphical content onto the portion of the sheet in a non-electronic form (5:37-56, updating with a modified barcode),

- f. wherein the second graphical content is associated with the updated information created (5:37-56., reflects addition of new information to the patient's file.)

However, Wang does not explicitly disclose erasing the portion of the sheet having the non-electronic representation of the first collection of media objects. Torii discloses an erasable recording material (Abstract) for a barcode (22:16) which may be erased and re-marked as needed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wang with Torii. One would have been motivated to utilize the erasable recording material of Torii with the disclosure of Wang so as to enable modification of the barcode in the same position (as illustrated in Fig. 7 of Wang) without taking up any more space on the sheet.

Claim 51: Wang and Torii disclose the method defined in claim 50. Wang further discloses wherein the updated information comprises a timestamp (5:5-11, time; Fig. 22: "12/31".)

Claim 52: Wang and Torii disclose the method defined in claim 50. Wang further discloses wherein the scanning the portion of the sheet is performed, prior to erasing, to obtain scanned information, and wherein the updated information is based on the scanned information (5:37-56.)

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Torii et al. (6,432,518) and in further view of Takayama (6,373,575.)

Claim 42: Wang and Torii disclose the method defined in claim 39. However, Wang does not explicitly disclose a scanned sheet feeder coupled to the scanner to send the sheet to the erasing unit if the sheet is re-writable. Takayama discloses a paper classification method wherein the paper is tested and sent to an erasing unit if it can be reused (Fig. 2; 4:32-46.) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Takayama with Wang. One would have been motivated to utilize the teachings of Takayama with Wang so as to enable classification of different paper types for reuse and recycling purposes (1:54-62.)

Claims 5, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Torii et al. (6,432,518) and in further view of Shibaki (5,764,368.)

Claim 5, 8, 23: Wang and Torii disclose the method defined in claim 2. However, Wang does not explicitly disclose wherein marking the first sheet comprises identifying open areas on the sheet based on scanned information and determining where to mark the sheet based on the open areas. Shibaki discloses a (2:5-12) a method for printing additional information at identified vacant printing areas. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wang and Torii with Shibaki. One would have been motivated to

Art Unit: 2174

combine the teachings of Wang and Torii with Shibaki so as to not overwrite previous information.

Claims 11, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al., in view of Cardullo et al. (3,713,148.)

Claim 11, 26, 35: Wang discloses the method defined in claim 9. However, Wang does not explicitly disclose wherein the first identifier comprises a radio frequency identifier (RFID). Cardullo discloses using RFID identifiers (Abstract.) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use RFID as identifiers as disclosed by Cardullo with the teachings of Wang. One would have been motivated to use RFID tags as they require no internal power, are relatively small in size and are portable (Cardullo, 2:30-64.)

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Ludtke et al. (6,260,063.)

Claim 16: Wang discloses the method defined in claim 1. However, Wang does explicitly disclose marking the sheet with a machine-readable indicator that indicates that the *sheet is not to be erased*. Ludtke discloses a write-protection mechanism for documents (7:34-64.) Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a write-protection mechanism as

Art Unit: 2174

taught in Ludtke to the disclosure of Wang. One would have been motivated to combine the teaching of Ludtke to that of Wang so as to provide a form of protection against inadvertent deletion / modification of important documents.

Claim 17: Wang and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is erasable (i.e. flag can be set / removed; 7:34-64.)

Claim 18: Wang and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is one of a predetermined shape, pattern, or color (7:34-64.)

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Geeslin (2002/0064113.)

Claim 47: Wang discloses a method comprising:

- a. detecting a writable mark when scanning a re-writable paper (Fig. 3: 'are there machine readable images?");
- b. wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium (Fig. 5-6);
- c. scanning the re-writable paper by a scanner that is configured to scan the images (3:8-12; 5:5-11, pictorial and textural features.)

Art Unit: 2174

However, Wang does not explicitly disclose preventing modification in response to detecting the writable mark. Geeslin discloses a methodology for protecting media from being modified / erased by using a write protection mark (par. 32-33.) Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to include write protection mechanism. One would have been motivated to include write protection mechanism of Geeslin with Wang so as to provide a form of protection against inadvertent deletion / modification of important documents.

Claims 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al., in view of Torii and in further view of Sellen et al. (2002/0052888.)

Claim 49: Wang and Torii disclose the method defined in claim 48. However, Wang does not explicitly disclose determining a difference between representations for the first and second collections; and erasing a portion of the sheet based on the difference between the representations of the first and second collections. Sellen discloses a method for electronic record storage wherein differences between representations on a document could be determined and compared so as to allow the user to modify (e.g. erase, annotate) the document (par. 31, Fig. 5.) Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wang and Sellen. One would have been motivated to combine the teachings of Wang and Sellen so as to enable a user to clearly see differences between representations of a document and make modifications based on such.

Response to Arguments

Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Li, 6,002,491.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2174

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Belousov whose telephone number is (571) 270-1695. The examiner can normally be reached on Mon-Fri (alternate Fri off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven P Sax/
Primary Examiner, Art Unit 2174

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5/4/2010

Application/Control Number: 10/816,251
Art Unit: 2174

Page 16